REMARKS

In the Office Action dated April 14, 2008, informalities were noted in claims 1, 2 and 8, all of which have been corrected.

Claims 1-4, 7-15, 17 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Pitris et al in view of Strommer et al and further in view of Hastings et al. This rejection is respectfully traversed for the following reasons.

As discussed in Applicants' previous response, the Pitris reference teaches an OCT system with a catheter configured for insertion into the body of a patient. The OCT system is integrated with an imaging system, which is described in the Pitris reference as being an x-ray system or a magnetic resonance system. The Pitris reference does not teach that the catheter has a magnetic field-generating element, nor does the Pitris et al reference teach the use of such a magnetic field-generating element in the context of an OCT system for magnetic navigation.

The Strommer reference discloses an OCT system having a catheter in combination with a medical positioning system (MPS), which makes use of magnetic field-generators for control and tracking of the catheter inside the human body, but there is no disclosure in the Strommer reference to make use of such magnetic field generators for *navigation*, magnetic or otherwise. Moreover, the Strommer reference does not disclose positioning of an electromagnetic field-generating element at the tip of a catheter.

The Hastings reference discloses a catheter having an electromagnetic field-generating element at the tip thereof, and *additional* magnetic elements for navigation of the catheter through the human body. The Hastings et al reference does not disclose an OCT system nor an x-ray system.

Applicants therefore respectfully submit the Examiner has simply combed the prior art, after having had the benefit of reading Applicants' disclosure, to locate a number of different references that each individually disclose portions of the subject matter claimed in the present application, but none of those references provides any guidance or motivation to a person of ordinary skill in the field of navigating instruments within the body of a patient to combine the teachings of those different references to arrive at the subject matter of independent claim 1 of the present application. Applicants submit it is not sufficient, for the purpose of substantiating a rejection under 35 U.S.C. §103(a), simply to point out different portions of the overall elements of a patent claim respectively in different references, and to rely merely on the fact that the references in question happen to be in the general field of medical imaging as a basis for allegedly substantiating the rejection. Even after the *KSR* decision, it is still not sufficient to substantiate a rejection under 35 U.S.C. §103(a) based *solely* on the position that the references in question are all from a common field of endeavor. This is merely a starting point for conducting the evidentiary analysis that is still necessary under the provisions of 35 U.S.C. §103(a).

In the present situation, Applicants respectfully submit there is no reason why a person of ordinary skill, starting with the Pitris reference, would also consider Strommer et al and Hastings et al references. If a person of ordinary skill begin thinking of modifying the Pitris et al reference along the lines of the teachings of the Strommer et al reference, this would result in an implementation of the imaging system with the OCT catheter and then, in accordance with the teachings of Strommer et al, an additional control system (the MPS) would be provided, in order to allow identification of the position of the catheter using magnetic field generators.

There is no reason, however, why such a person of ordinary skill would then take the additional step of further modification of such a combination in view of the teachings of Hastings et al, because there is no suggestion whatsoever in a combination of Pitris et al and Strommer et al that there would be a need for a better navigation system for the catheter. Both the Pitris et al and Strommer et al references teach only imaging, visualization and tracking, but do not provide any teachings at all concerning navigation. Simply tracking an instrument is not the same as navigating an instrument.

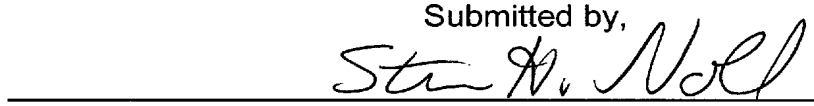
In the paragraph bridging pages 4 and 5 of the Office Action, the Examiner proposed a justification for combining the teachings of Pitris et al, Strommer et al and Hastings et al as being "for the purpose of facilitating a detailed integrated medical imaging diagnostic procedure of a patient where accurate guidance and integrated imaging create the best diagnostic data for treatment of a patient." At most, this general statement is the overall goal of almost every medical system wherein some type of imaging is used to visualize or track a medical instrument in a patient. Simply having knowledge of this overall goal, however, in no manner provides a person of ordinary skill in this field with any guidance or insight as to how to achieve that goal. In fact, there are so many hundreds of thousands of combinations that might be suitable for achieving that goal, that patentability is certainly deserving to an inventor or inventors who has the insight to sort through those many combinations to find a combination that actually achieves that goal. Simply having knowledge of a goal, and having the insight to determine the "right" combination that achieves that goal, are two completely different matters. Applicants respectfully submit that the Examiner has undertaken the analysis under 35 U.S.C. §103(a) in the reverse

manner as required by the applicable decisions of the United States Court of Appeals for the Federal Circuit. Applicants respectfully submit the Examiner has first selected the three references in question (Pitris et al, Strommer et al and Hastings et al) and has then devised an *ex post facto* reason for combining those references, with that particular reason itself not being discernible from any of the individual references. Applicants respectfully submit the only location where that insight is available is Applicants' disclosure, which is impermissible for use in formulating a rejection under 35 U.S.C. §103(a).

All claims of the application are therefore submitted to in condition for allowance, and early reconsideration of the application is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Submitted by,



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